

REMARKS

Reconsideration and withdrawal of the rejections of the application are respectfully requested in view of the amendments and remarks herewith.

I. STATUS OF THE CLAIMS AND FORMAL MATTERS

Claims 1-16 are pending. Claim 1 is amended without prejudice. No new matter is added.

Applicants expressly state that the claims, as amended, are intended to include and encompass the full scope of any equivalents as if the claims had been originally filed and not amended. Thus, Applicants hereby expressly rebut any presumption that Applicants have narrowed or surrendered any equivalents under the doctrine of equivalents by amending the claims, or by presenting any remarks in this paper, and in no way do Applicants disclaim any of the territory between the original claims and the amended claims with respect to any equivalent subject matter.

Other than the RCE fee, no other fees are required in connection with the filing of this Amendment. If any fee, however, is deemed necessary, authorization is given to charge the amount of any such fee to Deposit Account No. 08-2525.

II. 35 U.S.C. § 112, FIRST PARAGRAPH, REJECTION

Claims 1-16 were rejected under 35 U.S.C. §112, first paragraph, as allegedly lacking written description. The Examiner contends that the second proviso in claim 1 is not supported by the specification. Although Applicants expressly disagree with the Examiner's reasoning, the proviso is removed, thereby rendering the Section 112 rejection moot.

With the removal of this proviso, the Examiner may be motivated to re-apply the eight (8) CAS Registry entries against Applicants' claimed invention (see March 9, 2005 Office Action). Applicants respectfully urge the Examiner not to do so as the CAS Registry entries fail as anticipatory art.

The CAS Registry entries do not enable Applicants' invention. As the Examiner is aware, anticipation requires a two-part inquiry. First, the prior art must disclose each and every limitation of the claimed invention. See Oakley, Inc. v. Sunglass Hut Int'l, 316 F.3d 1331, 1339

(Fed. Cir. 2003). Second, the reference must enable one of skill in the art to practice the claimed invention. See Bristol-Myers Squibb Co. v. Ben Venue Labs., Inc., 246 F.3d 1368, 1374 (Fed. Cir. 2001); see also In re Donohue, 766 F.2d 531, 533 (Fed. Cir. 1985). To be enabling, a prior art reference must enable “one of ordinary skill in the art [to] practice the invention without undue experimentation.” Novo Nordisk Pharm., Inc. v. Bio-Technology General, Corp., 424 F.3d 1347, 1355 (Fed. Cir. 2005).

It is the Examiner’s burden to make a *prima facie* showing that the public possessed Applicants’ invention in order for a Section 102 rejection to be proper. “Such possession is effected if one of ordinary skill in the art could have combined the publication’s description of the invention with his [or her] own knowledge to make the claimed invention.” In re Donohue, 766 F.2d at 533.

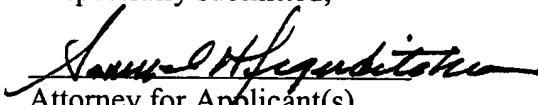
Here, the *prima facie* showing was not made. There is no indication that the public possessed Applicants’ invention. The eight CAS Registry entries merely show eight chemical structures without any indication of how they were made or whether they could be made without undue experimentation. As such, a Section 102 rejection based on the eight CAS registry entries is invalid as a matter of law.

Consequently, reconsideration and withdrawal of the Section 112, first paragraph, rejection are respectfully requested. Further, it is respectfully requested that the Examiner not re-apply the Section 102 rejection based on the eight CAS Registry entries.

CONCLUSION

In view of the amendments and remarks herewith, the application is in condition for allowance. The Examiner is asked to contact the undersigned in order to discuss this paper in more detail.

Respectfully submitted,



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